



**UNITED STATES DEPARTMENT OF COMMERCE**  
**United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/589,950    06/08/00    LIEBERMAN ZADJMAN    D    7544-PA01

IM22/0817

NEIL F MARTIN  
BROWN MARTIN HALLER & MCCLAIN  
1660 UNION STREET  
SAN DIEGO CA 92101-2926

EXAMINER

LAM, C

ART UNIT

PAPER NUMBER

1775

DATE MAILED:

08/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/589,950

Applicant(s)

LIEBERMAN ZADJMAN ET AL.

Examiner

Cathy Lam

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1775

***Claim Rejections - 35 USC § 112***

1. Claims 1, 3-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, it is vague and indefinite as to whether or not "a first film" is referring to "a removable material"? furthermore, the phrase "the film may be eliminated if the optical security film has stripping agent...." is unclear as to whether "the film" is referring to "a first film", and it is uncertain whether or not this "first film" and "the stripping agent" exist?

In claims 3 and 4, there are no antecedent basis for "the confidential information" and "said security measure" in the prior claims.

In claims 3 and 5, the term "and/or" is indefinite. Correction is required.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curiel (US 5913543).

The invention of claims 1-5 is unclear, with respect to the prior art rejection below, the claims will be given the broadest possible interpretation in view of the specification.

Art Unit: 1775

Curiel discloses a tamper evident article comprised of a transparent outer film (42), an adhesive (102), a hologram (122), an adhesive having differential adhesion properties (124), a polyester film (126) and an adhesive (128) (see Fig. 6 & 7, col 9 L 28-48).

The transparent outer film (42) which contains holograms particles (104, 106, 107, 108, 109, 110) is releasably attached to another hologram containing layer (102) (Fig. 6). Once the hologram in the outer film (42) is separated from the hologram in the layer (102). The layers can not be put back together, thus impairing the ability of someone to reuse the hologram (col 3 L 35-51).

Curiel is silent about engraving optical elements onto the removable material, nor does it teach the ability of resisting frictional forces.

One skill in the art would fabricate an optical security film using Curiel's idea and modify it slightly because the hologram can be embossed onto the films or layers (col 8 L 45-50), also having a security device in the removable piece and can not be put back together again was clearly discussed in Curiel (col 3 L 45-51).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cathy Lam whose telephone number is (703) 308-2418. The examiner can normally be reached on 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (703) 308-3822. The fax phone numbers for the organization where this application or proceeding is assigned are (703)


Application/Control Number: 09/589,950

Page 4

Art Unit: 1775

305-5436 for regular communications and (703) 305-5436 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Cathy Lam  
Primary Examiner  
Art Unit 1775

cfl  
July 29, 2001